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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,480	01/09/2002	Philip Y. Chang	AUS920010982US1	6093
7590	11/25/2005			
Frank C. Nicholas CARDINAL LAW GROUP Suite 2000 1603 Orrington Avenue Evanston, IL 60201			EXAMINER WANG, LIANG-CHE	
			ART UNIT 2155	PAPER NUMBER
DATE MAILED: 11/25/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	10/042,480		CHANG ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Liang-che Alex Wang		2155	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 August 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. Claims 1-17 are presented for examination.

#### ***Response to Arguments***

2. Applicant's arguments filed 8/29/2005, have been fully considered but they are not persuasive.
3. In that remarks, applicant's argues in substance:
  - a. That: Albaugh does not disclose receiving transmission capability from a first company and a second company and storing transmission capabilities.

This is found not persuasive because Albaugh disclosed member profiles includes the transaction process which links the initiator's business process (first company's transmission capability) and the target participant's business process (second company's transmission capability), and information must be received and stored in profile 125 for profile 125 to contain the contexts.

#### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-17 are provisionally rejected under the judicially created doctrine of double patenting over claims 1-20 of copending Application No. 10/015,234. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.
6. Claims 1-17 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-20 of U.S. Patent No. 6,912,551 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because the subject matter claimed in the instant application is fully disclosed in the referenced patent since the referenced patent and the instant application are claiming common subject matter, as follows: A method of automating the matching of business to business processes comprising: receiving transmission capability from a first company and a second company; storing transmission capabilities; receiving a request from one of the first and second companies to do business with the other company; and determining at least one translation path between the first and second companies based on the transmission capabilities and translation capabilities. (see claims 12-14 of US Patent Number 6,912,551 B2.)
7. Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other US Patent

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Albaugh et al., US Publication Number 2003/0115182 A1, Hereinafter Albaugh.

10. Referring to claim 1, Albaugh has taught a method of automating the matching of business to business processes (abstract, [0010] matching between business members, [0036] member profile contains information of trading partners corresponding to target participants) comprising:

- a. receiving transmission capability from a first company and a second company ([0037] lines 6-9, initiator's business process and target participant's business process are stored in the member profile 125, information must be received in order to be stored into the member profile);
- b. storing transmission capabilities ([0037] lines 6-9, and Figure 1 item 125);
- c. receiving a request from one of the first and second companies to do business with the other company ([0058-59], and figures and 7);
- d. and determining at least one translation path between the first and second companies based on the transmission capabilities and translation capabilities ([0010], [0037], the HUB provides document translation and process translation

based on each member's transmission capabilities and translation capabilities stored in the member profile).

11. Referring to claim 2, Albaugh has further taught wherein the transmission capabilities represent process formats supported by each company [0010] each company might use a different format of process such as xXML or EDI).
12. Referring to claim 3, Albaugh has further taught storing transmission capabilities in a managed hub ([0037] lines 6-9);.
13. Referring to claim 4, Albaugh has further taught wherein the translation capabilities represent mapping from one data format to another ([0010]).
14. Referring to claim 5, Albaugh has further taught storing the translation capabilities in a managed hub([0039]).
15. Referring to claim 6, Albaugh has further taught wherein the request from one of the first and second companies is regarding any business to business computer transaction ([0058], the request is made from a member searching for compatible trading partners).
16. Referring to claim 7, Albaugh has further taught wherein the translation path represents a number of data transformation and process translation capabilities ([0010]).
17. Referring to claims 8-17 claims 8-17 encompass the same scope of the invention as that of the claims 1-7. Therefore, claims 8-17 are rejected for the same reason as the claims 1-7.

*Conclusion*

18. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Liang-che Alex Wang whose telephone number is (571)272-3992. The examiner can normally be reached on Monday thru Friday, 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (571)272-4001. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Liangche Alex Wang  
November 21, 2005

*LW*

  
SALEH NAJJAR  
SUPERVISORY PATENT EXAMINER